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10/588,033	10/01/2007	Atsushi Okumura	09812.0565	4073

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EXAMINER	
HARVEY, DAVID E	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/588,033	OKUMURA, ATSUSHI	
	Examiner	Art Unit	
	DAVID E. HARVEY	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 October 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *01 August 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *4/20/2007, 10/26/2006, 8/1/2006*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1. **The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.**

2. **The examiner notes that, as described in the instant specification, the recited process of "matching" appears to refer to a process in which the content of a menu is updated to reflect changes in recorded media content such that the content of the menu allegedly "matches" the recorded content [e.g., Note: instant Figure 11; and lines 5-8 of claim 24].**

3. **The following is a quotation of the second paragraph of 35 U.S.C. 112:**

   The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 1-19, 22, and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

   1) In claim 1, lines 5, the phase "which makes matching" is indefinite because it is unclear, in the context of this claim, what the phrase means and/or to what it refers (e.g., What is being "matched?"). Clarification is needed. Similar clarification is needed in line 5 of claim 2, line 12 of claim 9, line 5 of claim 22, and line 12 of claim 23.

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. **Claims 24-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter**.

Claims 24 and 25 are directed to a computer "program". Computer programs, per se, constitute non-functional descriptive material and, as such, are non-statutory: i.e., a computer program is not a process, machine, manufacture, or composition of matter.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-4, 6, 7, 9-11, 13-15, and 22-25 are rejected under 35 U.S.C. 102(a) as being anticipated by Japanese Patent Document #2004-318923 to Shimizu et al.

The instant examiner agrees with the position set forth in written opinion, submitted by applicant for consideration on 4/20/2007 **[note the sixth page thereof]**, that the above listed claims are anticipated by the system described in paragraphs 0064-0078 of the provided translation of Japanese Patent Document #JP2004318927.

9. Claims 20 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent Publication #2002/0012304 to Nakahara et al.

As is shown in Figures 4 and 5, Nakahara et al. discloses an editing system which includes:

A) Circuitry for determining whether or not the loaded subject disc is a DVD + RW type disc that, by definition, includes a menu **[i.e., note step "S13" of Figure 4]**; and

B) Circuitry for disabling the recording of additional information on the loaded subject disc when the disc is not determined to be of the DVD + RW type **[i.e., note steps "S7", "S8" and "S13" of Figure 4]**.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> **(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.**

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Document #2004-318923 to Shimizu et al. in view of Japanese Patent Document #2004-120035 to Kamio et al.

The instant examiner agrees with the position set forth in written opinion, submitted by applicant for consideration on 4/20/2007 **[note the sixth page thereof]**, that claims 5 and 12 are obvious over paragraphs 0064-0078 of the provided translation of Japanese Patent Document #JP2004318923 in view of the teachings set forth in paragraphs 0007-0026 of provided translation of Japanese Patent Document #JP2004120035.

12. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Publication #2002/0012304 to Nakahara et al. in view of US Patent Publication #2003/0147629 to Kikuchi et al.

As is shown in Figures 4 and 5, Nakahara et al. discloses an editing system which includes:

A) Circuitry for determining whether or not the loaded subject disc is a DVD + RW type disc that, by definition, includes a menu **[i.e., note step "S13" of Figure 4]**;

B) Circuitry for disabling the recording of additional information on the loaded subject disc when the disc is not determined to be of the DVD + RW type **[i.e., note steps "S7", "S8" and "S13" of Figure 4]**;

and

C) Circuitry for editing the loaded subject disc, including the recording of additional information, when the loaded subject disc is determined to be of the DVD + RW type **[i.e., Note: paragraphs 0133 and 0134; and steps "S32" to "S35" of Figure 5]**.

Claim 1 differs from the showing of Nakahara et al. only in that Nakahara et al. does not specifically describe the editing and rewrite processes **[i.e., @ steps "S32" to "S35" of Figure 5]** as including the updating/rewriting of the menu stored thereon to "match" the changes/additions made to the recorded content.

Kikuchi et al has been cited because it at least evidences that it was known to have been desirable, if not necessary, to have updated the menu of a DVD + RW type disc when the content of the DVD + RW type disc has been edited so that the content of the menu "matches" the media content of the disc **[e.g., See paragraphs 0019]**. In light of this showing, the examiner maintains that it would have been obvious to one of ordinary skill in the art to have "modified" the editing and rewriting processing described in Nakahara et al. **[@ steps "S32" to "S35" of Figure 5]** to have includes the updating and rewriting of the menu to reflect (i.e., "match") the changes made in the media content.

13. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Publication #2002/0012304 to Nakahara et al. in view of US Patent Publication #2003/0147629 to Kikuchi et al. for the same reasons that were set forth above for claim 1.

14. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Publication #2002/0012304 to Nakahara et al. in view of US Patent Publication #2003/0147629 to Kikuchi et al. for the same reasons that were set forth above for claim 2. Additionally:

Nakahara et al. broadly identifies the media content stored on the disc as representing music or image information **[Note paragraphs 0005]**. While not specifically describe, the examiner takes Official Notice that it was notoriously well known in the DVD + RW type disc recording art for such recorded image information to have represented either video information or still picture information; e.g., wherein the examiner notes that one need not go further than applicant's own specification, or the showing of Kikuchi et al , for support of this position.

15. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Publication #2002/0012304 to Nakahara et al. in view of US Patent Publication #2003/0147629 to Kikuchi et al. for the same reasons that were set forth above for claim 3.

16. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Publication #2002/0012304 to Nakahara et al. in view of US Patent Publication #2003/0147629 to Kikuchi et al., for the same reasons that were set forth above for claim 3, in further view of Japanese Patent Document #2004-318923 to Shimizu et al. Additionally:

Claims 7 recite that the updating of the disc is performed in response to an instruction to eject the disc. It is noted that the advantages of finalizing/rewriting such edited discs at the time of disc ejection was well known in the art given the time and computing power required for such finalizing/rewriting **[e.g., Note paragraph 0074-0075 of Shimizu et al]**. As such, the examiner maintains that it would have been obvious to one of ordinary skill in the art to have further modified the system disclosed by Nakahara et al. to have includes such an advantageous feature.

17. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Publication #2002/0012304 to Nakahara et al. in view of US Patent Publication #2003/0147629 to Kikuchi et al., for the same reasons that were set forth above for claim 3, in further view of Japanese Patent Document #2004-318923 to Shimizu et al. Additionally:

Claims 8 recite that the updating of the disc is performed in response to an instruction to eject the disc. It is noted that the advantages of finalizing/rewriting such edited discs at the time of disc ejection was well known in the art given the

time and computing power required for such finalizing/rewriting **[e.g., Note paragraph 0074-0075 of Shimizu et al]**. As such, the examiner maintains that it would have been obvious to one of ordinary skill in the art to have further modified the system disclosed by Nakahara et al. to have includes such an advantageous feature. As is was notoriously well known in the computer arts, the examiner maintains that it would have been obvious to one of ordinary skill in the art to have required the user to respond to a displayed inquiry to confirm the exiting/ending of the editing process prior to the rewriting of the disc; i.e., to give the user one last chance to cancel the edits thereby avoiding the execution of undesired changes.

18. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Publication #2002/0012304 to Nakahara et al. in view of US Patent Publication #2003/0147629 to Kikuchi et al. for the same reasons that were set forth above for claim 3. Additionally:

Note the displayed image illustrated in Figure 6A of Nakahara et al. which confirm the fact that the disc is of the type that can be edited.

19. Claims 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Publication #2002/0012304 to Nakahara et al. in view of US Patent Publication #2003/0147629 to Kikuchi et al. for the same reasons that were set forth above for claim 9.

20. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Publication #2002/0012304 to Nakahara et al. in view of US Patent Publication #2003/0147629 to Kikuchi et al., for the same reasons that were set forth above for claim 9, in further view of Japanese Patent Document #2004-318923 to Shimizu et al. Additionally:

Claims 15 recite that the updating of the disc is performed in response to an instruction to eject the disc. It is noted that the advantages of finalizing/rewriting such edited discs at the time of disc ejection was well known in the art given the time and computing power required for such finalizing/rewriting **[e.g., Note paragraph 0074-0075 of Shimizu et al]**. As such, the examiner maintains that it would have been obvious to one of ordinary skill in the art to have further modified the system disclosed by Nakahara et al. to have includes such an advantageous feature.

21. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Publication #2002/0012304 to Nakahara et al. in view of US Patent Publication #2003/0147629 to Kikuchi et al., for the same reasons

that were set forth above for claim 9, in further view of Japanese Patent Document #2004-318923 to Shimizu et al. Additionally:

Claims 19 recite that the updating of the disc is performed in response to an instruction to eject the disc. It is noted that the advantages of finalizing/rewriting such edited discs at the time of disc ejection was well known in the art given the time and computing power required for such finalizing/rewriting **[e.g., Note paragraph 0074-0075 of Shimizu et al]**. As such, the examiner maintains that it would have been obvious to one of ordinary skill in the art to have further modified the system disclosed by Nakahara et al. to have includes such an advantageous feature. As is was notoriously well known in the computer arts, the examiner maintains that it would have been obvious to one of ordinary skill in the art to have required the user to respond to a displayed inquiry to confirm the exiting/ending of the editing process prior to the rewriting of the disc; i.e., to give the user one last chance to cancel the edits thereby avoiding the execution of undesired changes.

22. **Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Publication #2002/0012304 to Nakahara et al. in view of US Patent Publication #2003/0147629 to Kikuchi et al. for the same reasons that were set forth above for claim 9. Additionally:**

The examiner notes that the recitations of claims 17-19 appear to be purely functional in nature in that the claims set forth what the confirmation input "represents". In the regard, the examiner contends that it would have been obvious to one of ordinary skill in the art that the modified system of Nakahara et al. would have operated as illustrated by the flow charts of Figures 4-5 each time the system was enabled regardless of what the enablement was in response to; i.e., regardless of what the confirmation input "represents".

23. **Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Publication #2002/0012304 to Nakahara et al. in view of US Patent Publication #2003/0147629 to Kikuchi et al. for the same reasons that were set forth above for claim 9.**

24. **Claim 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Publication #2002/0012304 to Nakahara et al. in view of US Patent Publication #2003/0147629 to Kikuchi et al. for the same reasons that were set forth above for claim 9. Additionally:**

The examiner notes that one the disc is detected/confirmed by the modified system, the modified determines whether the menu is record thereon as it should be.

25. **Claim 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Publication #2002/0012304 to Nakahara et al. in view of US Patent Publication #2003/0147629 to Kikuchi et al. for the same reasons that were set forth above for claim 23. Additionally:**

The examiner maintains that one skilled in the art would have understood a software implementation of the modified system to have been both desirable and obvious [e.g., as is evident via claim 28 of the Nakahara et al. publication].

26. The following "prior art" is noted:

A) US Patent #7,580,935 to Wyllie
[Note lines 9-20 of column 5].

B) US Patent Document #2003/0227474 to Oetzel
[Note paragraphs 015 and 042].

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID E. HARVEY whose telephone number is (571) 272-7345. The examiner can normally be reached on M-F from 6:00AM to 3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Marsh D. Banks-Harold, can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DAVID E HARVEY/

Primary Examiner, Art Unit 2621

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